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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/783,169  
Filing Date: February 19, 2004  
Appellant(s): PANNELL ET AL.

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Robert D. Atkins  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 10, 2008 appealing from the Office action mailed July 11, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

Appellant's brief presents arguments relating to drawings objections under 37 CFR 1.83(a). This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 74-89 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

Claims 74, 78 and 84 recite "...government regulations and manufacturer's recommendations..." Although the specification, on page 10, paragraph 21, recites as such, the specification fails to teach what those regulations and recommendations are. Since the "government regulations and manufacturer's recommendations" are not defined, the specification fails to enable one skilled in the art to make and/or use the invention in accordance with undefined or changing regulations and recommendations.

**Claims 74-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 74, 78 and 84 recite "...government regulations and manufacturer's recommendations..." The recitation of regulation and recommendations renders the claims indefinite because regulations and recommendations are subject to change.

Claim 74 recites "structures" in line 23. It appears to be a double inclusion of the residential home recited in lines 3-5.

### **(10) Response to Argument**

Regarding appellant's argument directed to the enablement rejection, appellant merely asserts that one of ordinary skill in the art would easily understand how to ascertain the relevant government regulations and manufacturer's recommendations without supporting evidence. Appellant asserts that government regulations and manufacturer's recommendations are readily available from published literature and websites. Although government regulations may be published, identification of the pertinent documents is lacking in the specification. Same applies to manufacturer's recommendations.

Appellant argues that the claimed invention is not indefinite because the invention merely requires compliance with the existing government regulation or manufacturer's recommendation as of the filing date.

Appellant's argument and logic fails for at least four reasons:

First, appellant's argument is not commensurate in scope with the claimed invention. The claims do not recite, "...existing government regulation and manufacturer recommendation **as of the filing date**..." Emphasis added.

Second, using Claim 74 as an example, Claim 74 reads, "...the tubing having a plurality of openings cut through its wall structure at selected points in accordance with government regulations and manufacturer's recommendations..." Hypothetically, assume that government regulations and manufacturer's recommendations required the "selected points" to be every 5 inches at the time of filing. Subsequent to appellant's filing date, assume that government regulations and manufacturer's recommendations

were changed to require the "selected points" to be every 3 inches. If a device were later made and/or used in accordance with Claim 74 that had "selected points" every 3 inches, Claim 74 would be readable on the device having "selected points" every 3 inches because the Claim 74 does not identify the particular publications or their effective dates. Then, if Claim 74 is allowable, appellant's specification would purport to teach government regulations and manufacturer's recommendations that are not in existence at the time of the filing date. To read in "as of the filing date" into the claims would be to impermissibly read limitations into the claims.

Third, appellant fails to teach any particular government regulation or manufacturer's recommendation. Does Claim 74 require that the device be in accordance with all government regulations and manufacturer's recommendations or merely some of the government regulations and manufacturer's recommendations? For example, Claim 74 recites, "...the tubing transporting a chemical solution selected from the group consisting of pesticides, herbicides, fertilizers, animal retardants, and vegetation pre-emergence..." Must one of ordinary skill in the art who makes and uses the claimed invention for pesticide provide openings at selected points in accordance with government regulations and manufacturer's recommendations for fertilizers? Appellant's lack of disclosure creates undue experimentation. The recitation of "government regulations and manufacturer's recommendation" asserts undue breadth of the claims. One of ordinary skill in the art in the pesticide field of endeavor would not necessarily be aware of government regulations pertaining to fertilizers. Prior art does not provide methods to foresee and comply with future government regulations or

across disciplines. Appellant does not even provide any guidance as to determine the application government regulations and manufacturer's recommendation.

Fourth, again, by way of example, Claim 74 recites, "...the tubing having a plurality of openings cut through its wall structure at selected points in accordance with...manufacturer's recommendations..." Any individual who is one of ordinary skill in the art making the claimed invention would be considered the manufacturer. Therefore, the manufacturer's recommendations are strictly dependent on the individual making the claimed invention. It is unreasonable to predict the scope of the recommendations what would be possible based on whoever is making the claimed invention.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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